

## **II. Rejections Under 35 U.S.C. § 103(a)**

The Office has maintained the rejection of claims 43-62 and 64-67 under 35 U.S.C. § 103 (a) as being unpatentable over EPA 590,604 ("EP '604") in view of U.S. Patent No. 4,878,604 ("Sramek") and Chemical Abstract 89:117546 ("the '546 abstract"), for the reasons set forth at pages 2-3 of the outstanding Office Action, as well as the comments made on the Advisory Action mailed June 28, 2001. Applicant respectfully traverses for the reasons of record, as well as for the following additional reasons.

In the Response filed June 5, 2001, Applicant argued that there would have been no motivation to combine EP'604 and Sramek at least because EP'604 is directed to aqueous polymer compositions while Sramek is generally directed to resins which are dissolved in organic solvents, which include a minimum amount of water. See p. 6 of the June 5, 2001, Response. Because the teaching of EP'604 that freeze-thaw stability is a problem in aqueous based compositions would not have suggested that the Sramek compositions, which only contain a minimum amount of water, would have freeze-thaw stability problems, there would have been no motivation to combine the EP' 604 copolymer with the Sramek composition to enhance freeze-thaw stability, as has been asserted by the Office. *Id.* at p. 7. In response, the Office has argued that EP'604 and Sramek teach overlapping ranges of water concentrations. See Advisory Action mailed June 28, 2001, and the outstanding Office Action, p. 2, penultimate paragraph.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

The Office's argument fails to fully address Applicant's traversal, but instead merely mentions the portion of the EP '604 reference that supports the Office's position, while ignoring those teachings which do not. This approach is improper. The references must be considered in their entirety, i.e., as a whole, including portions that would lead away from the claimed invention. See M.P.E.P. § 2141.02, Rev. 1, Feb. 2000, p. 2100-95.

While EP '604 does teach that water may be present in the hairspray composition at a level of from 2 to 99 weight percent, EP '604 also teaches an aqueous polymer composition compatible with a wide range of carriers. See EP '604, p. 2, lines 31-32. *Preferably*, the carrier comprises water, and only optionally a VOC (a volatile organic compound). See p. 5, lines 16-17. Importantly, the prepared examples contain a majority of water. See Example 38, which contains 335 g of water compared to only 100 g of alcohol. Thus EP '604 emphasizes aqueous based polymer compositions. In fact, one of the inventive aspects of EP '604 is its remedy for some of the freeze-thaw stability problems experienced by aqueous based polymer compositions, e.g., the undesirable substantial increase in viscosity discussed at p. 2, lines 24-25. Clearly, EP'604 is drawn to improvement of aqueous-based polymer compositions.

Sramek, on the other hand, teaches hairspray resins which are dissolved in hydrocarbon solvents, such as ethanol and isopropanol, and advises using the minimum amount of water. See column 5, lines 59-67. The examples of Sramek do not even mention water, but instead use either hydrocarbon propellant A, or absolute

ethanol as solvents. See columns 12-19, examples 1-41. Sramek does not mention freeze-thaw stability.

Therefore, the Office's statement that it "would have been obvious to . . . add the polymer of [EP] '604 to the composition of Sramek to impart freeze-thaw resistance" is entirely without basis. There is simply no teaching or suggestion in the art that Sramek would have freeze-thaw stability problems. Rather, as mentioned above, the teachings suggest just the opposite; that the compositions of Sramek would not have freeze-thaw stability problems because Sramek is directed to hydrocarbon based compositions instead of the water based compositions taught by EP'604 to have freeze-thaw stability problems.

The Office has now alleged additional motivation other than freeze-thaw stability by stating that EP'604 supplies other excellent performance characteristics as motivation to combine with Sramek. See Advisory Action mailed June 28, 2001. The Office has further alleged that it would have been obvious to additionally combine the polymer of the '546 abstract because of its high effectiveness and water resistance. While, EP'604 and the '546 abstract disclose certain desired characteristics for their copolymers, these characteristics are taught for the copolymers as separately used in distinctly different hairspray compositions. For example, the hairspray compositions of EP'604 contain water, while the '546 abstract composition does not mention water, but instead comprises 95.63% SDA 40. See e.g., the hairspray compositions p. 8, examples 19-35 of EP'604; and the hairspray composition taught by the '546 abstract.

Merely listing general teachings of performance characteristics of different copolymers used in distinctly different hairspray compositions, as the Office has done, cannot provide the motivation necessary to suggest Applicant's claimed combination of copolymers. If the Office's reasoning was generally followed, it would have been obvious to combine every hairspray resin with every other hairspray resin taught to have some desirable performance characteristic, without regard to other pertinent considerations, such as the compatibility of the resins, or other teachings within the references themselves which teach away from the combination. Such reasoning at best amounts to nothing more than an "obvious to try" standard, which as the Office is well aware, is clearly improper. See M.P.E.P. § 2145(X)(B).

Furthermore, Sramek does not supply any motivation or suggestion to combine the EP'604 and the '546 abstract copolymers. Instead, Sramek teaches "a hair setting composition comprising from about 0.5% to 8% by weight of a hair setting resin containing pendant carboxyl radicals . . . and a solvent for the resin wherein from about 10% to 100% of the carboxyl radicals are neutralized with a neutralizing agent consisting of (a) . . . a long chain amine . . . and (b) . . . an amine or alkanolamine." See SUMMARY OF THE INVENTION, column 3, lines 16-38. The hair setting resin may be "[a]ny conventional resin-containing pendant carboxyl radicals known to be suitable for holding the hair in a desired style". See column 4, lines 28-30. A plethora of such conventional resins is taught. See column 4, line 44 to column 5, line 58. Thus, even if one of ordinary skill in the art were to combine the teachings of Sramek

with those of EP'604 and the '546 abstract, Sramek does not provide motivation or suggestion to pick and choose Applicant's claimed copolymers over the multitude of other copolymers known in the art. Nor does it provide motivation for combining Applicant's claimed copolymers in a single hairspray composition.

Motivation to combine references must be clear and particular. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). Applicant has shown that no such motivation exists to combine EP'604, Sramek and the '546 abstract to arrive at Applicant's claimed invention. For at least these reasons the rejection should be withdrawn.

### **III. Rejections Under 35 U.S.C. § 112, First Paragraph**

The Office has rejected claims 43-62 and 64-67 under 35 U.S.C. § 112, first paragraph for lack of written description because, according to the Office, nowhere in the specification as originally filed does Applicant disclose a polymer chosen from acrylates/hydroxyesters acrylates copolymers. The Office has further rejected claims 43-62 and 64-67 under 35 U.S.C. § 112, first paragraph, for lack of enablement because nowhere in the specification does Applicant disclose polymers which are copolymers of acrylates and hydroxyesters of acrylates. Applicant respectfully traverses these rejections.

Regarding these rejections, Applicant refers the Office to the Supplemental Amendment filed July 30, 1999, which indicates at p. 16 and p. 21 that Acudyne 255 in Example 6 of the specification is an acrylates/hydroxyesters acrylates copolymer. See

also p. 1806 of the International Cosmetic Ingredient Dictionary and Handbook attached to the Amendment filed January 13, 2000, which lists Acudyne 255 as an acrylates/hydroxyesters acrylates copolymer. Accordingly, Applicant submits that there is both written description and enablement for the claimed invention and as such, the rejections under § 112, first paragraph, should be withdrawn.

#### **IV. Rejections Under 35 U.S.C. § 112, Second Paragraph**

The Office has rejected claims 43-62 and 64-67 under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter of the invention. The Office has indicated that "chosen from" is unclear because it is not known whether a Markush group is intended. In order to set the record straight, Applicant wishes to clarify that "chosen from" is not intended to be a Markush group, but is another acceptable alternative language format. See MPEP § 2173.05(h) (which states that "Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims."). Applicant finds "no uncertainty or ambiguity with respect to the question of scope or clarity" of this claim language. Here, the Office has not shown improper alternative claim language, and therefore has not carried his burden of indicating how or why the claims are indefinite.

Regarding the Office's assertions that the intent of the slash is unclear, Applicant points out that the slash is often used in the art to separate monomers used to form a

copolymer, and that is the intent of the slash here. Regarding the assertion that "hydroxyester acrylates" is meaningless, Applicant avers that this nomenclature is well known in the art, as evidenced by its use in the International Cosmetic Ingredient Dictionary and Handbook, cited above, and that one of ordinary skill in the art would therefore be apprised of its meaning.

In view of the above, the rejections under §112, second paragraph, are in error and should be withdrawn.

## V. Conclusion

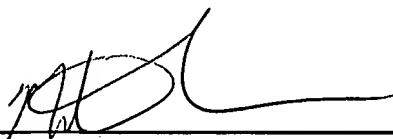
In view of the foregoing remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: December 19, 2001

By:   
Matthew Whipple  
Reg. No. 47,217

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com